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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,322	03/16/2005	Christina Lutz	CU-4060 BWH	8831
26530 7590 09/28/2010 LADAS & PARRY LLP 224 SOUTH MICHIGAN AVENUE SUITE 1600 CHICAGO, IL 60604				
EXAMINER				
CHAWLA, JYOTI				
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1781				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/522,322

**Applicant(s)**

LUTZ ET AL.

**Examiner**

JYOTI CHAWLA

**Art Unit**

1781

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 33-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Applicant's submission filed on 7/6/2010 has been entered. Claims 33-36 and 48-49 have been amended and new claims 64-66 have been added in the application. Claims 33-66 are pending and examined in the current application.

#### *Claim Objections*

##### Duplicate claim Objection:

When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim 33 recites "A confectionery article in non liquid form consisting essentially of herbal mixtures, where the herbal mixtures consists essentially of an extract of a mixture of herbs and an extract of *Stevia rebaudiana* wherein the herbs are peppermint, sage, yarrow and thyme"(emphasis added)

Claim 34 recites "A confectionery article in non liquid form consisting essentially of herbal mixtures, where the herbal mixtures consists essentially of a mixture of herb extracts and an extract of *Stevia rebaudiana* wherein the herbs are peppermint, sage, yarrow and thyme" (emphasis added).

Thus the claims differ from each other only in the recitation of "an extract of a mixture of herbs" (as recited in claim 33) "a mixture of herb extracts" (as recited in claim 34), which are referred to as equivalents, throughout applicant's disclosure (see specifically, publication of application paragraphs[0001], [0012-0013],[0016]). Further applicants' remarks dated 5/22/2009, page 7, lines 20-24 also clarify that the phrases are equivalents by stating that "the terms "an extract of a mixture of herbs" and a "mixture of herb extract" may indeed be deemed being in some way or the other equivalent". Based on this claim 33 and 34 are being deemed as substantial duplicates of each other and claim 34 is objected to under 37 CFR 1.75 as being a substantial duplicate of claims 33.

Similarly claim 36 is objected to under 37 CFR 1.75 as being a substantial duplicate of claims 35 for the same reasons as stated above regarding claims 33 and 34.

Additionally claims 38, 40, 42, 44, 46, 48 and 62 (which depend from claims 33 to 36 respectively) are also objected to under 37 CFR 1.75 as being a substantial duplicate of claims 37, 39, 41, 43, 45, 47 respectively for the same reasons as stated above regarding objection of claims 33 and 34.

Claims 49 through 52 are substantial duplicate claims, similarly claims 53 through 56 are substantial duplicate claims, claims 57-60 are substantial duplicate claims, and claims 61-63 are substantial duplicate claims for the same reasons as stated above regarding objection of claims 33 and 34.

Applicant's arguments regarding the claim objections have been noted, however, they are not convincing because

- applicant's disclosure (see specifically, publication of application paragraphs [0001], [0012-0013], [0016]) refers to the phrases "an extract of a mixture of herbs" (as recited in claim 33) "a mixture of herb extracts" (as recited in claim 34), as equivalents.
- applicants' remarks dated 5/22/2009, page 7, lines 20-24 also clarify that the phrases are equivalents by stating that "the terms "an extract of a mixture of herbs" and a "mixture of herb extract" may indeed be deemed being in some way or the other equivalent".
- applicant's new explanation of how the phrases "an extract of a mixture of herbs" and "a mixture of herb extracts" differ from each other (remarks of 7/6/2010, page 7) by claiming the differences such as, "presence of different herbs" and "concentration of individual compounds can differ due to shift in extraction equilibrium" "each extract can be a result of different extraction conditions" (remarks of 7/6/2010, page 7, last two paragraphs) has not been found persuasive as the above statements do not find support in the original disclosure nor do these limitations appear in the amended claims.

Furthermore, applicant is reminded that the claims that have been objected to for being substantial duplicates are product claims and even if applicant's explanation is considered, the explanations pertain to the process limitations, which if presented in product claims will make the objected claims product-by-process claims. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. When the reference teaches a product that appears to be the same as, or an obvious variant of, the product set forth in a product-by-process claim, the claim is unpatentable even though the prior product was made by a different process. See *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) and *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). See also MPEP § 2113.

***Claim Rejections - 35 USC § 112***

Rejection of claims 33-60 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter have been withdrawn based on applicants amendments of 7/6/2010.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Note:**

The terms "an extract of a mixture of herbs" and a "mixture of herb extract" are being treated as substantial equivalents, as discussed in the section of duplicate claim objection based on applicant's disclosure which uses the two terms as alternatives, for example see publication paragraph 13, lines 3-5 where two phrases are clearly disclosed as alternatives "an extract of a mixture of plurality of herbs or a mixture of a corresponding number of extracts". Further support for this is obtained from applicant's remarks of 5/22/09, page 7, lines 20-24, where "the terms "an extract of a mixture of herbs" and a "mixture of herb extract" may indeed be deemed being in some way or the other equivalent" has been stated. Applicant's remarks of 7/6/2010 have been considered but have not been found persuasive, As discussed in the duplicate claim objections.

**(A)** Claims 33-52, 57-60 and new claims 64-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirschner et al (US 6352713 B1), hereinafter Kirschner, in view of the combination of Zhao (2002/0132037), Teranishi et al (JP57068772 A, English abstract only) hereinafter Teranishi and Kano et al (JP 09194370 A, English abstract and machine translation), hereinafter Kano.

**The references and rejection are incorporated herein and as cited in the office action mailed March 4, 2010.**

Regarding the amendments to claims reciting "consisting essentially of" in all independent claims and their dependent claims e.g., claim 33 recites "A confectionery article in non-liquid form consisting essentially of herbal mixtures consisting essentially of an extract of a mixture of herbs and an extract of Stevia rebaudiana wherein the herbs are peppermint, sage yarrow and thyme." (Emphasis added) have been considered. The amended claims recite transitional phrase "consisting essentially of" with herb extracts, wherein the herbs are peppermint, sage, yarrow and thyme and an extract of Stevia rebaudiana. The recitation of transitional phrase "consisting essentially

of" as recited in amended claims interpreted as "comprising" for the purposes of searching and applying of prior art because

- dependent claims , such as 37, which depends from claim 33 adds elements, such as other herb extracts that materially affect the composition as recited in claim 33 and
- applicant's disclosure defined the scope of the phrase consisting essentially of" for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention.

Therefore, applicant's recitation of transitional phrase "consisting essentially of" in all the claims is being interpreted as "comprising". Applicant is further referred to MPEP 2111.03 [R-3] where it is clearly stated For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355.

Amendment to claims of 7/6/2010 includes the term "consisting essentially of" in all independent claims and their dependent claims which have been considered, however, reciting "consisting essentially of" does not change the scope for prior art application and the amended claims 33-52, 57-60 remain rejected over prior art as made of record in the previous office action of 3/4/2010.

The new product claims 63-66, recite "A confectionery article consisting essentially of an extract of mixed herbs of peppermint, sage, yarrow, thyme and *Stevia rebaudiana* produced by the process consisting of the steps of: mixing added herbs, said herbs being peppermint, sage, yarrow and thyme and the dried herb of *Stevia rebaudiana*; extracting an extract from the mixture; thickening the mixture extract, if appropriate; and processing the resultant mixture into a confectionery article of the desired form." (Claim 64) wherein the confectionery can be in a non-liquid form (Claim 65) or liquid or syrup form (claim 66). New claims includes product limitations recited in independent claims

33-36, however, new claim 64 also includes process limitations, making it a product-by-process claim. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Thus new claims 64-66 are rejected for the same reasons of record as applied to claims 33-36 in the previous office action of 3/4/2010.

**(B)** Claims 53-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirschner in view of Zhao as applied to claims 33-34 and 37-38, further in view of the Yotka et al (WO 91/03147), hereinafter Yotka.

Kirschner, Zhao, Teranishi and Kano have been relied upon to reject claims 33-34 and 37-38 as discussed above.

**The references and rejection are incorporated herein and as cited in the office action mailed March 4, 2010.**

**(C)** Claims 61-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oppenheimer et al (US 4980169), hereinafter Oppenheimer, in view of the combination of Teranishi (JP 57068772A), Kirschner (US 6352713 B1), and Zhao (2002/0132037),.

**The references and rejection are incorporated herein and as cited in the office action mailed March 4, 2010.**

### ***Response to Arguments***

Applicant's arguments with respect to amended claims 33-63 and new claims 64-66 of 7/6/2010 have been considered and addressed in the rejection above.



Applicants' arguments regarding Kirschner, Zhou and Oppenheimer have not been found persuasive.

i) Applicants argue that "none of the prior art teaches or suggests a confectionery article in non liquid form consisting essentially of an herb extract of (or a mixture of herb extracts of peppermint, sage yarrow and thyme as well as stevia extract" (Remarks, 7/6/10, Page 9, last paragraph). Applicants seem to arrive at this conclusion because of the amendment due to the transitional phrase "consisting essentially of" (Remarks page 9, last line to page 10, line 1). In response applicant's attention is directed to the rejection of claims all claims, specifically claims 33-52, 57-60, where interpretation of the amended phrase has been explained.

The amended claims recite transitional phrase "consisting essentially of" with herb extracts, wherein the herbs are peppermint, sage, yarrow and thyme and an extract of Stevia rebaudiana. The recitation of transitional phrase "consisting essentially of" as recited in amended claims interpreted as "comprising" for the purposes of searching and applying of prior art because

- dependent claims, such as 37, which depends from claim 33 adds elements, such as other herb extracts that materially affect the composition as recited in claim 33 and
- applicant's disclosure defined the scope of the phrase consisting essentially of for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention.

Therefore, applicant's recitation of transitional phrase "consisting essentially of" in all the claims is being interpreted as comprising. Applicant is further referred to MPEP 2111.03 [R-3] where it is clearly stated For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355.

ii) Applicants argue that Kirschner is irrelevant "because it is limited to the concept of sweetening the obnoxious taste of vitamin C and B by adding glycyrrin. It thus requires ingredients that are excluded by the currently pending claims" (remarks, page 10, last paragraph). Applicants seem to arrive at this conclusion because, "Kirschner teaches chewable nutritional tablet composition featuring a vitamin C/vitamin B9 (folic acid) combination" (Remarks, 7/6/10, page 10, paragraph 2).

a. In response, First of all, applicants are referred to the rejected claims and interpretation of "consisting essentially of" as discussed in rejection and response to argument i) above. Since the transitional phrase "consisting essentially of" in all the claims is being interpreted as comprising, therefore relevant prior art or combination of prior art references can be a confection which includes the recited ingredients along with other ingredients without limitation.

b. Secondly, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, **Kirschner** teaches a nutritional composition that can be a confection (Column 8, lines 59 to Column 9, line 1, see specifically, line 65 of Column 8) in a non liquid form (Column 8, lines 59-60) based on herbal mixtures comprising an extract of a mixture of herbs, or a mixture of herb extracts (Column 13, lines 54-57) wherein the herbs are peppermint, sage, yarrow and thyme (Column 13, lines 24-54). Thus, Kirschner teaches of the herb extracts as instantly claimed, which is also confirmed by applicants' remarks on Page 8, paragraph 2.

Regarding extract of *Stevia rebaudiana*, applicant is referred to rejection of claims 33-34 above and as cited in the previous office action.

iii) Applicant's argument that Zhou's product can not be combined with Kirschner to render the pending claims obvious because Zhou's product contains, "isolated terpene

glycosides, e.g. from Stevia...together with at least one of glucose, fructose and maltose (Remarks, Page 10, paragraph 6). Applicants' argument is not persuasive because the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Further, applicants' claim recites "A confectionery article consisting essentially of ..." (emphasis added), i.e., comprising and the relevant prior art or combination of prior art references can be a confection which includes the recited ingredients along with other ingredients without limitation.

Furthermore, there are no specific proportions or amounts of stevia extract recited in the claims, so the argument that amount of stevia extract as disclosed by Zhou does not meet the claim limitation is not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., amount of stevia extract) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

iv) Applicants' argument against Oppenheimer is "Oppenheimer teaches a orally dissolving confection with a volatile oil and a sensorial undetected amount of an agent for modifying the perception of the volatile oil" (See Remarks, of 7/6/10, page 11, second last paragraph), and thus does not teach applicants' invention as claimed. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant

case applicants are referred to the rejection of claims 61-63 over Oppenheimer in view of the combination of Teranishi, Kirschner and Zhao.

Further in response to applicant's argument that "stevioside is clearly taught as sweetener and not as volatile oil modifying agent" (Remarks, page 11, second last paragraph, lines 1-3), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

v) Applicants arguments about reference to Kano is "Kano does not consider Stevia alone as sufficiently sweet" (Remarks, page 11, lines 4-5), about Teranishi and Yataka is that "they use stevia extract or isolated stevioside for sweetening carbonated drinking water or chewing gum, respectively" (Remarks, page 11, lines 6-7), which are directed at individual references separately and argue a specific intended use of a component. In response, the applicant is reminded that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

vi) Applicant argues that "5 herb extracts , i.e., peppermint, sage, yarrow, thyme and stevioside extracts. The effect is that the overall taste perception of all 5 components changes... an unexpected change in every one of the 4 remaining taste components without repressing these tastes by superimposition of sweetness" (Remarks, page 12, lines 5-11). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., unexpected change in every one of the 4 remaining taste components without repressing these tastes by superimposition of sweetness) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from

the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTI CHAWLA whose telephone number is (571)272-8212. The examiner can normally be reached on 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JC/  
Examiner  
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/Keith D. Hendricks/  
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